

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

PA ADVISORS, LLC

Plaintiff,

v.

GOOGLE INC., et al.,

Defendants.

Civil Action No. 2:07-cv-480-TJW

JURY

**PA ADVISORS, LLC'S ANSWER TO GOOGLE INC.'S
FIRST AMENDED COUNTERCLAIM**

Plaintiff PA Advisors, LLC hereby Answers the First Amended Counterclaim of Defendant Google, Inc. (“Google”), filed on June 25, 2009, by corresponding paragraph number as follows:

Parties

1. Admitted upon information and belief.
2. Admitted.

Jurisdiction and Venue

3. Admitted.
4. Admitted.

Count I: Declaratory Judgment of Non-Infringement

5. PA Advisors, LLC incorporates by reference paragraphs 1 through 4 of this Answer as if fully set forth herein. Google’s purported incorporation of paragraphs 1 through 22 of its First Amended Answer and Affirmative Defenses is improper and requires no response. Subject to the foregoing, PA Advisors, LLC denies the merits of Google’s denials of liability, defenses and affirmative defenses, and PA Advisors, LLC denies all averments in Google’s First

Amended Answer and Affirmative Defenses that are inconsistent with the relief requested in PA Advisors, LLC's Second Amended Complaint ("SAC").

6. Admitted.
7. Admitted.
8. To the extent the allegations in paragraph 8 are other than legal conclusions (which require no response), denied.

Count II: Declaratory Judgment of Invalidity and/or Unenforceability

9. PA Advisors, LLC incorporates by reference paragraphs 1 through 8 of this Answer as if fully set forth herein. Google's purported incorporation of paragraphs 1 through 22 of its First Amended Answer and Affirmative Defenses is improper and requires no response. Subject to the foregoing, PA Advisors, LLC denies the merits of Google's denials of liability, defenses and affirmative defenses, and PA Advisors, LLC denies all averments in Google's First Amended Answer and Affirmative Defenses that are inconsistent with the relief requested in the SAC.

10. To the extent the allegations in paragraph 10 are other than legal conclusions (which require no response), denied.

Count III: Unenforceability

11. Denied.
12. Admitted.
13. Admitted.
14. PA Advisors, LLC admits that the International Search Report ("ISR") form for the PCT Application indicates that it was completed on March 12, 2000. PA Advisors, LLC further admits that the ISR form identifies the following U.S. Patent Nos.: 5,696,963; 5,761,662; and 5,778,380. PA Advisors, LLC further admits that each of the three above-referenced patents are categorized on the ISR form as "Y" references. PA Advisors, LLC further admits that the ISR form includes a legend with pre-printed text describing a "Y" reference as follows: "document of particular relevance; the claimed invention cannot be considered to involve an

inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.” Except as so admitted, PA Advisors, LLC lacks knowledge or information sufficient to form a belief about the truth of the remaining matters alleged in paragraph 14.

15. PA Advisors, LLC admits that U.S. Patent No. 5,696,963 is entitled “System, Method and Computer Program Product for Searching Through an Individual Document and Group of Documents,” and indicates on its face that it issued to Don Ahn on December 9, 1997. Except as so admitted, the remaining allegations in paragraph 15 are denied.

16. PA Advisors, LLC admits that U.S. Patent No. 5,761,662 is entitled “Personalized Information Retrieval Using User-Defined Profile,” and indicates on its face that it issued to Vasanthan S. Dasan on June 2, 1998. Except as so admitted, the remaining allegations in paragraph 16 are denied.

17. PA Advisors, LLC admits that U.S. Patent No. 5,778,380 is entitled “Intelligent Resource Transformation Engine for Translating Files,” and indicates on its face that it issued on July 7, 1998. Except as so admitted, the remaining allegations in paragraph 17 are denied.

18. PA Advisors, LLC admits that the ISR form indicates on its face that it was mailed on April 20, 2000. PA Advisors, LLC further admits that the ’067 Patent indicates that Edward Etkin was an attorney of record on the ’286 Application. PA Advisors, LLC lacks knowledge or information sufficient to form a belief about the truth of the allegation that the International Search Report and prior art cited therein were maintained in the files of Mr. Etkin. Except as so admitted or otherwise responded to, the remaining allegations in paragraph 18 are denied.

19. PA Advisors, LLC admits that the ISR form and the references cited therein were not provided to the PTO by the named inventor of the ’067 patent, the prosecuting attorney, and/or other persons having a duty of candor to the PTO during the prosecution of the ’067 Patent. Except as so admitted, the remaining allegations in paragraph 19 are denied.

20. Denied.

21. To the extent the allegations in paragraph 21 are other than legal conclusions (which require no response), denied.

Exceptional Case

22. Denied.

Relief Requested

To the extent necessary, PA Advisors, LLC denies that Google is entitled to the relief requested in the section of its First Amended Counterclaim labeled "Relief Requested," or any relief whatsoever.

Dated: July 20, 2009

Respectfully submitted,

By: /s/ Marc A. Fenster
Marc A. Fenster, CA Bar No. 181067
E-mail: mfenster@raklaw.com
RUSS, AUGUST & KABAT
12424 Wilshire Boulevard, 12th Floor
Los Angeles, California 90025
Telephone: 310/826-7474
Facsimile: 310/826-6991

Andrew W. Spangler - Lead Counsel
TX Bar No. 24041960
E-mail: spangler@spanglerlawpc.com
SPANGLER LAW P.C.
208 N. Green Street, Suite 300
Longview, Texas 75601
Telephone: 903/753-9300
Facsimile: 903/553-0403

David M. Pridham, R.I. Bar # 6625
E-mail: david@pridhamiplaw.com
LAW OFFICE OF DAVID PRIDHAM
25 Linden Road
Barrington, Rhode Island 02806
Telephone: 401/633-7247
Facsimile: 401/633-7247

Patrick R. Anderson, MI SB #P68961
E-mail: patrick@prapllc.com

PATRICK R. ANDERSON PLLC
4225 Miller Road, Bldg. B-9, Suite 358
Flint, Michigan 48507
Telephone: 810/275-0751
Facsimile: 248/928-9239

Ari Rafilson, TX State Bar No. 24060456
Email: ari@rafilsonlawllc.com
THE RAFILSON LAW FIRM, PLLC
1318 Royal Palm Lane
Carrollton, Texas 75007
Telephone: 214/789-4035
Facsimile: 972/236-5397

**Attorneys for Plaintiff
PA ADVISORS, LLC**

CERTIFICATE OF SERVICE

I hereby certify that the counsel of record who are deemed to have consented to electronic service are being served on July 20, 2009 with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3). Any other counsel of record will be served by electronic mail, facsimile transmission and/or first class mail on this same date.

Dated: July 20, 2009

/s/ Marc A. Fenster
Marc A. Fenster